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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,161	07/24/2003	Maureen Greene	44669-0008	9722

43463 7590 04/07/2005

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EXAMINER

MORAN, KATHERINE M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,161

Applicant(s)

GREENE ET AL.

Examiner

Katherine Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Applicant's pre-amendment of 3/7/05 has been received and considered. Also, the petition to make special of 3/7/05 has been reviewed and granted (as noted in Office correspondence of 3/25/05).

Specification

1. The disclosure is objected to because of the following informalities: pg.7, line 10: delete "to".
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 5 recites "elastic polymers".
3. The use of the trademark lycra has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology-spandex.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13 and 14 recite steps not disclosed in the specification as originally filed, including: the step of positioning the elastic portion to secure the cover around the pinna of the ear, and positioning the adhesive portion to secure the cover at the tragal area of the ear, adhering the adhesive portion to the tragal area of the ear or facial tissue adjacent to the tragal area, and wherein the cover completely covers the external auditory canal of the ear.

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7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 contains the trademark/trade name lycra. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe spandex and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 9, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (U.S. 5,689,831). Harris '831 discloses the invention as

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claimed. Harris teaches a cover for a human ear, the cover comprising a layer of plastic polymeric, flexible material sized and shaped to completely cover the external ear portions, an elastic portion (not labeled, col. 2, lines 25-27) for securing the layer of flexible material over the external portions of the ear, and an adhesive portion 26,28, with the adhesive and elastic portions both coupled to the layer of flexible material. Elastic material is commonly made from spandex, cotton and/or nylon fibers. The adhesive portion is formed from a pressure-sensitive adhesive coating coupled to the flexible material. Harris teaches the method steps recited in claims 13 and 14, including positioning the elastic portion to secure the cover around the pinna of the ear and positioning the adhesive portion to secure the cover at the tragal area of the ear.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris '831 in view of Harris (U.S. 4,6640,229). Harris '831 discloses the invention substantially as claimed. However, Harris doesn't teach elastic material coupled to the flexible material by an adhesive, heat weld, or

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radio frequency weld. Harris also doesn't teach adhesive material coupled to the layer of flexible material by an adhesive, hat weld, or radio frequency weld.

Applicant's specification does not disclose criticality for the means of attaching the adhesive or elastic to the cover. Harris '229 teaches an ear cover with an elastic strip/adhesive assembly which is coupled to the cover by heat sealing. It is well known in the art that various types of fastening mechanisms are functionally equivalent. Heat welding and adhesive are a few examples. These fastening means may be used interchangeably depending upon the desired aesthetic effect. Further, the specification does not give an indication of why employing one of the adhesive or heat weld would be desirable over the other and states that the claimed various means of attachment are well known. Also, the method of forming or assembling a device recited in an apparatus claim is not germane to the patentability of the structure of the claimed device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to couple the adhesive material or elastic to the flexible material by means of adhesive, heat, or radio frequency weld, because all these means are readily available and inexpensive while providing a secure bond.

Conclusion

12. The prior art made of record on the attached PTO-892, and not relied upon, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The

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examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (703) 872-9306. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

April 1, 2005

A handwritten signature in black ink, appearing to read 'K Moran', with a stylized flourish at the end.

Katherine Moran

Primary Examiner, AU 3765